

REMARKS

Amendments

Amendments to the Claims

Applicant has amended the claims to more particularly point out what Applicant regards as the invention. In particular, Applicant has amended the independent claims to specify that the claimed augmentations and content are exported to launch an external application. No new matter has been added as a result of these amendments.

Rejections

Rejections under 35 U.S.C. § 102(b)

Claims 1-5, 11-15, 21-25, 31 and 32

Claims 1-5, 11-15, 21-25, 31 and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,146,552 of Cassorla et al. Claims 5, 15 and 25 have been cancelled. Applicant respectfully submits that Cassorla does not disclose each and every element of the invention as claimed in claims 1-4, 11-14, 21-24, 31 and 32.

Cassorla discloses an electronic document application that enables a first user to annotate locations within an electronic document with notes and bookmarks. The annotations may be exported to second user, who initiates execution of the electronic document application to review the annotations and optionally further annotate the content.

In contrast, the invention as claimed in the amended independent claims exports augmentations and the associated content selection to an external application to launch the external application. Cassorla does not teach or suggest that exporting data from the electronic document application of the first user causes the electronic document application of the second user to launch as claimed.

Accordingly, Applicant respectfully submits that the invention claimed in claims 1-5, 11-15, 21-25, 31 and 32 is not anticipate by Cassorla under 35 U.S.C. § 102(b) and respectfully requests the withdrawal of the rejection of the claims.

Rejections under 35 U.S.C. § 103

Claims 6, 7, 9, 10, 16, 17, 19, 20, 26, 27, 29, and 30

Claims 6, 7, 9, 10, 16, 17, 19, 20, 26, 27, 29, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cassorla in view of U.S. Patent No. 5,890,172 of Borman et al. Applicant respectfully submits that the combination does not teach each and every element of the invention as claimed in claims 6, 7, 9, 10, 16, 17, 19, 20, 26, 27, 29, and 30.

Claims 6, 7, 9, 10, 16, 17, 19, 20, 26, 27, 29, and 30 depend from one of independent claims 1, 11 and 21. In order to have a proper *prima facie* case of obviousness, Borman must teach the claimed element that is missing in Cassorla. However, Borman is directed toward using web site identifiers in a web page to retrieve information that is related to the web page. Borman does not teach or suggest that exporting augmentation and content data causes an external application to launch as claimed. Therefore, the combination of Cassorla and Borman cannot render obvious Applicant's invention as claimed in claims 6, 7, 9, 10, 16, 17, 19, 20, 26, 27, 29, and 30, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination.

Claims 8, 18 and 28

Claims 8, 18, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cassorla in view of Borman as applied to claim 6, and further in view of U.S. Patent No. 6,442,144 of Hansen et al. Hansen qualifies as prior art only under 35 U.S.C. § 102(e) because it issued after Applicant's filing data. Applicant does not admit that Hansen is prior art and reserves the right to challenge its designation as such at a later date. Nonetheless, Applicant respectfully submits that the combination of Cassorla, Borman and Hansen does not teach each and every limitation of Applicant's invention as claimed in claims 8, 18 and 28.

Claims 8, 18 and 28 depend from one of independent claims 1, 11 and 21. In order to have a proper *prima facie* case of obviousness, Hansen must teach the claimed element that is missing in the base combination of Cassorla and Borman. However, Hansen is directed toward creating a graphic representation of a network of devices.

Hansen does not teach or suggest that exporting augmentation and content data causes an external application to launch as claimed. Therefore, the combination of Cassorla, Borman and Hansen cannot render obvious Applicant's invention as claimed in claims 68, 18 and 28, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination.

New Claims

New claims 33 and 34 have been added to claim the subject matter of claims 31 and 32 under 35 U.S.C. § 112, ¶ 6. Applicant respectfully submits claims 33 and 34 are allowable for at least the reasons set forth above for claims 23 and 32

SUMMARY

Claims 1-4, 6-14, 16-24 and 26-34 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-8300 x309.

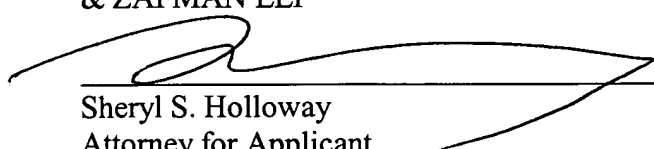
Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP

Dated: 10/28, 2004


Sheryl S. Holloway
Attorney for Applicant
Registration No. 37,850

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300 x309